



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/606,314 | 06/29/2000 | Richard Fike | IVGN 174.1 DIV | 1340 |
| 65482 7590 07/16/2010 LIFE TECHNOLOGIES CORPORATION C/O INTELLEVATE P.O. BOX 52050 MINNEAPOLIS, MN 55402 | | | | |
| EXAMINER | | | | |
| SCHUBERG, LAURA J | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1657 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 07/16/2010 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/606,314

Applicant(s)

FIKE ET AL.

Examiner

LAURA SCHUBERG

Art Unit

1657

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27, 36, 92-95, 103, 110, 111, 122-124 and 126-137 is/are pending in the application.
- 4a) Of the above claim(s) 27, 36, 92-95, 103, 110, 111 and 122 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 123, 124, 126-137 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to papers filed 05/10/2010.

During a telephone interview on May 3, 2010, the Examiner agreed to allow Applicant to switch inventions and elect claims 123-125 which were filed as new claims on 10/02/2008.

New claims 126-137 have been added. Claim 125 has been newly canceled. Claims 27, 36, 92-95, 103, 110-111, 122-124, 126-137 are currently pending.

Claims 27, 36, 92-95, 103, 110-111 and 122 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claims 123, 124, 126-137 have been examined on their merits.

Claim Objections

Claims 132-133 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 132-133 are dependent upon claim 123 but are drawn to a liquid medium while claim 123 is drawn to a powder medium. Therefore it is possible to apply art that infringes upon the dependent claims without infringing upon the parent claim.

A proper dependent claim shall not conceivably be infringed by anything which would not also infringe upon the basic claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 123, 124, 126-137 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants have included the limitation "protein-free mammalian cell culture medium" in independent claim 123. There is not sufficient support in the disclosure as originally filed for this limitation; thus it is being considered new matter. The disclosure as originally filed only supports nutritive media in general, those specific basal medias listed on page 18 of the specification as well as serum-free media. While the basal

medias may be protein free, they are insufficient on their own to support the culture of mammalian cells and are therefore do not meet the requirements of a protein-free mammalian cell culture medium. A suitable protein-free mammalian cell culture media must contain supplements in addition to the basal media in order to support the growth of the mammalian cell as evidenced by the teachings of Hamilton et al (In Vitro 1977) which demonstrates that protein-free media used for the culture of animal cells requires essential nutrients in order to be effective (page 537, column 1, page 538, table 1, and page 544, column 2). Applicant's disclosure does not describe an animal culture media that is protein-free and can be used successfully for the culture of animal cells as required by the claims.

An amendment to the claims or the addition of a new claim must be supported by the description of the invention in the application as filed. In re Wright, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir.1989). Applicant is required to cancel the new matter in the reply to this Office Action.

The introduction of claim changes which involve narrowing the claims by introducing elements or limitations which are not supported by the as-filed disclosure is a violation of the written description requirement of 35 U.S.C. 112, first paragraph. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996).

Applicant is hereby notified that the addition of new matter into the claims has necessitated the removal of the art rejection over the claims. However, removal of new matter will result in the reinstatement of the art rejection.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 134 and 136 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 134 recites the limitation "said medium" in line 1 of the claim.

It is unclear which medium claim 134 is referring to because claim 123 which it is dependent upon recites two mediums, an agglomerated medium and a non-agglomerated medium. Applicant needs to clarify which medium is referred to in claim 134.

Claim 136 recites the limitation "said sterilization" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim as it is dependent upon claim 123 which does not recite the limitation of sterilization. It appears that the claim should be dependent upon claim 135 which does recite the limitation of sterilization.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 132-133 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamilton et al (In Vitro 1977).

Claims 132-133 are drawn to a reconstituted medium at a desired pH for culturing a mammalian cell that has been reconstituted from an agglomerated powder.

Hamilton et al teach a protein-free culture media used for the culture of Chinese hamster cells (CHO cells-animal cells) (pages 537-538). Applicant's claim 123, which claim 133 is dependent upon requires that the agglomerated powder medium have the properties of reduced dusting and a larger particle size than a non-agglomerated medium, however this does not appear to provide a structurally different culture medium once the medium is reconstituted. While the properties of the powder appear to be changed it is not clear if the reconstituted medium will be structurally different.

"Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979)

The use of 35 U.S.C. §§ 102 and 103 rejections for product-by-process claims has been approved by the courts. "[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

Therefore the liquid, protein-free, animal culture of Hamilton appears to meet the claim limitations of claim 132-133 as far as structural requirements for the liquid medium are concerned.

Therefore Hamilton et al anticipate Applicant's Invention as claimed.

Response to Arguments

Applicant's arguments with respect to claims 123, 124, 136-137 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAURA SCHUBERG whose telephone number is (571)272-3347. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on (571) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Leon B Lankford/
Primary Examiner, Art Unit 1651

Application/Control Number: 09/606,314

Page 10

Art Unit: 1657

Laura Schuberg